

13 Rec'd PCT/PTO 14 JUN 1993



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

There application of : Heikkilä et al.  
International Application No. : PCT/FI91/00011  
International Filing Date : 10 January 1991  
U.S. Serial No. : 07/910,133  
U.S. Filing Date : 14 July 1992  
For : A PROCESS FOR THE  
SIMULTANEOUS PRODUCTION OF  
XYLITOL AND ETHANOL

RECEIVED

OCT 20 1993

OFFICE OF PETITIONS  
A/C PATENTS

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT

S I R :

The above-identified application was held to be abandoned in a paper from the Patent and Trademark Office dated February 25, 1993, for failure to timely file an oath or declaration. The finding that the oath or declaration was not timely filed was based on a finding that the filed oath or declaration did not identify the application properly. Exhibit A. However, the finding that the filed oath or declaration did not identify the above-identified application properly is inconsistent with Rule 1.5, and thus should be withdrawn.

The above-identified application is based on an International Application, PCT/FI/00011 which claims a January 15, 1990 priority date. The specification, claims, drawing and the National Phase filing fee for the above-identified

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
Commissioner of Patents and Trademarks,  
Washington, D.C. 20231, on

Date: June 10, 1993

Reg. No. 30,588

Signature

Walter Scott

application were forwarded to the Patent and Trademark Office on July 14, 1992, i.e. within thirty months of the priority date.

On September 9, 1992 (i.e., within thirty-two months of the priority date), the Assignee filed, by Express Mail with an Express Mail Certificate, a declaration that identified the above-identified application by its International Application Number and Filing Date. Exhibit B. The transmittal letter accompanying the declaration authorized the Office to charge any fees to Kenyon & Kenyon's deposit account. *Id.* Thus, the issue is whether the declaration filed on September 9, 1992 sufficiently identified the above-identified application.

Rule 5 (37 C.F.R. § 1.5(a)) entitled "IDENTIFICATION OF APPLICATION, PATENT, OR REGISTRATION" specifies what is necessary and sufficient to identify a pending U.S. patent application. Rule 5 states, in relevant part, that:

When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number, e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. (Emphasis added).

As the timely filed declaration identified the above-identified application by "the international application number," the Assignee submits that the declaration fulfilled the identification standard set forth in the Rules of Practice, namely, Rule 1.5(a). As the Rules were complied with, the identification was proper. Thus, the finding that the declaration did not properly identify the above-identified application is inconsistent with the Rules and should be reversed.

Once the declaration is found to have complied with Rule 1.5, the Assignee submits that the holding of abandonment is without basis and should be withdrawn.

The Assignee further submits that International Application No. PCT/FI91/00011 identifies one, and only one, U.S. Patent Application, namely U.S. Serial No. 07/910,133. Thus, the Assignee submits that using the International Application No. performs the same function the alternative means of identifying the application perform, namely to uniquely identify the U.S. patent application. As Serial No. 07/910,133 is uniquely identified by International Application No. PCT/FI91/00011, there is no rational basis to find that the identification given in the timely filed application was not sufficient. Therefore, for this reason as well, the Assignee requests that the Office withdraw the finding that the declaration did not properly identify the application, and consequently the holding that the above-identified application was abandoned.

Please charge any fee associated with this communication to Deposit Account 11-0600. A duplicate copy of this paper is enclosed for deposit account charging purposes.

Respectfully submitted,

KENYON & KENYON

Date:

June 10, 1993

  
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